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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,948	10/04/2000	Jeffrey Benson	SF025001	7864
Xin Wen 2800 Bridge Parkway Redwood City, CA 94065			EXAMINER GOOD JOHNSON, MOTILEWA	
			ART UNIT 2628	PAPER NUMBER
			MAIL DATE 10/01/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/679,948

Applicant(s)

BENSON ET AL.

Examiner

M GOOD JOHNSON

Art Unit

2628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No./Mail Date: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim(s) **1-45** is/are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled “Clarification of ‘Processes’ under 35 U.S.C. 101”). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-23, 25-27, 30, 31 and 33-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilkins, US 2004/0133924 A1, "Techniques for Synchronizing any of a Plurality of Associated Multimedia Assets in a Distributed System".

Regarding claim 1, Wilkins discloses a method for manipulating a digital image (0002, digital image processing) comprising: identifying an image for processing at a local client computer (0113, line 7, image processed by the local computer device) sending the image to a remote server (0113, lines 12-15, saving changes to the server over the network from a local computing device); manipulating either locally or remotely parameters associated with the image without modifying the image itself (0113, transmitting the edit list and other metadata to the remote computing device); synchronizing the local client computer and remote server including updating metadata for one of the local client computer and the remote server using metadata of the other. (0115, lines 1-4, synchronizing all associated multimedia assets whether locally or remotely)

Regarding claim 3, Wilkins discloses manipulating step includes manipulating a proxy image associated with the image. (0030, line 17, a modified proxy image)

Regarding claim 4, Wilkins discloses proxy image is a lower resolution image than the image. (0076, lines 13-14 a resultant proxy image having a lower resolution than the digital negative, i.e. image)

Regarding claim 5, Wilkins discloses proxy image is a higher resolution image than the image. (0076, lines 13-14 a resultant proxy image having a higher resolution than the digital negative, i.e. image)

Regarding claim 6, Wilkins discloses manipulating the proxy image includes creating metadata describing the manipulations to the image, applying the metadata to the proxy image and displaying the modified proxy image. (0080, lines 1-12, edit list and links between images encoded in meta-data that allows one to open and view any image)

Regarding claim 7, Wilkins discloses manipulating step includes . . . a. selecting between the image and a proxy image . . . , b. modifying the selected image . . . , and c. displaying the modified selected image. (0087, lines 1-10, detecting the incoming image as either a proxy image, a modified image, and determining the method of association, and generating an output)

Regarding claim 8, Wilkins discloses storing the metadata as a file associated with the image at each of the local client computer and the remote server. (0081, lines 1-14, the edit list, i.e. meta-data, is a representative file associated with a different multimedia assets)

Regarding claim 9, Wilkins discloses rotation information. (0117, lines 7-8, image-editing operation, such as rotate)

Regarding claim 10, Wilkins discloses cropping information. (0117, lines 7-8, image editing operation, such as crop)

Regarding claim 11, Wilkins discloses metadata includes user interface state information. (0075, lines 1-6, operations that are part of the state description)

Regarding claim 12, Wilkins discloses step of manipulating the parameters includes capturing state information defining a state of the manipulations at a predefined time and selecting a previous state at the request of the user. (0055, lines 1-7, state operation which describe an operation applied to the photo in which each operation can be turned on and off for the edit list parameter associated with the parameter, which Examiner interprets as a predefined time and selection of a previous state by the user)

Regarding claim 13, Wilkins discloses capturing a history of the state information and selecting any of the previous states without traversing back through each intermediary state . . . (0055, lines 1-11, allow a user to reapply operations identified by the edit list and undo or disable other operations regardless of the order and independent of the order, which Examiner interprets as not traversing the list, because the operations are not dependent on the other operations)

Regarding claim 14, Wilkins discloses parameter that can be manipulated can be selected order parameters. (0078, lines 8-10, meta-data including ordering information)

Regarding claim 15, Wilkins discloses image parameters include the state of the user interface. (0075, lines 1-6, operations that are part of the state description)

Regarding claim 16, Wilkins discloses image parameters include image archival information. (0055, lines 1-7, state operation which describe an operation applied to the

photo in which each operation can be turned on and off for the edit list parameter associated with the parameter, which Examiner interprets as a predefined time and selection of a previous state, i.e. archival information)

Regarding claim 17, Wilkins discloses image parameters include annotation information. (0102, lines 1-7, the edit list data associated with the image can include text strings, which Examiner interprets as inclusive of annotation information)

Regarding claim 18, Wilkins discloses image parameters include backprint information. (0091, lines 1-15, a printer edit list passed through to a printer port, which Examiner interprets as back print information)

Regarding claim 19, Wilkins discloses image parameters include order information. (0078, lines 8-10, meta-data including ordering information)

Regarding claim 20, Wilkins discloses image parameters include pricing information. (0078, lines 8-10, meta-data including price information)

Regarding claim 21, Wilkins discloses image parameters include image archival information. (0055, lines 1-7, state operation which describe an operation applied to the photo in which each operation can be turned on and off for the edit list parameter associated with the parameter, which Examiner interprets as a predefined time and selection of a previous state, i.e. archival information)

Regarding claim 22, Wilkins discloses defining a personal template that describes a particular configuration for the parameters . . . (0075, lines 1-6, edit list includes a list of individual operations, which Examiner interprets as a personal template)

Regarding claim 23, Wilkins discloses account parameters include verification data for the client. (0078, lines 1-8, security feature such as an encryption key to prevent unauthorized access with a key for how to access the photo specified by the edit list, which Examiner interprets as verification)

Regarding claims 25 and 26, Wilkins discloses synchronization step is bi-directional (includes checking for conflicts between metadata . . .). (0116, lines 15-22, efficiently synchronizing the modified photos over a network to maintain coherency when network usage vs. processor time is a consideration, which Examiner interprets as conflicts)

Regarding claim 27, Wilkins discloses receiving a selection from the user regarding the client and synchronizing the local client computer and remote server . . . storing two different states of the metadata at each . . . alerting the user includes displaying a dialog box to the user from which a selection can be made. (0116, lines 15-22, efficiently synchronizing the modified photos over a network to maintain coherency when network usage vs. processor time is a consideration, which Examiner interprets as selection for a user needs)

Regarding claim 30, Wilkins discloses a printer output file including profiles for different printers available through the remote server . . . (0092, lines 1-4, edit list allow a user to toggle viewing/output display)

Regarding claim 31, Wilkins discloses displaying on both the local client computer and the remote server a similar image metaphor for manipulating the original

image. (0115-0117, a digital image cached locally or remotely synchronized to reflect all modification of an associated multimedia asset)

Regarding claim 33, Wilkins discloses further comprising prompting the user to experience a new remote server function . . . (0115-0117, a digital image cached locally or remotely synchronized to reflect all modifications of an associated multimedia asset)

Regarding claim 34, Wilkins discloses metadata describing the manipulations without modifying the image, the metadata being stored at the computer . . . (0122-0123, the edit list is a part of a file embedded within a digital image, stored in memory)

Regarding claim 35, Wilkins discloses local client computer is selected from the group of PDA, portable computer, kiosk, fax machine, digital camera and docking station. (0082, lines 4-26, image source such as camera, kiosk), and other digital image sources)

Regarding claim 36, Wilkins discloses connection between the local client computer and remote server is wireless. (0094, lines 13-20, I/O ports connected to transmit the image provided interconnected, which Examiner interprets as inclusive of a wireless port)

Regarding claims 37-39, Wilkins discloses synchronization step occurs at a next open session (end of current session; in real time) . . . (0115-0117, a digital image cached locally or remotely synchronized to reflect all modifications of an associated multimedia asset)

Regarding claim 40, Wilkins discloses parameters include print parameters. (0085, lines 10-12, edit list configured to modify a digital image including commands to printers)

Regarding claim 41, Wilkins discloses parameters include print calibration parameters. (0085, lines 13-14, re-rasterizing a digital image to a printing need, which Examiner interprets as print calibrations)

Regarding claim 42, Wilkins discloses parameters include display parameters. (0092, lines 1-4, edit list could all user to toggle viewing/output display states)

As per independent claims 43-45, they are rejected based upon similar rational as above independent claim 1.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins as applied to claim 1 above, and further in view of Black et al., U.S. Patent Number 7,222,147 B1.

Regarding claim 2, however it is noted that Wilkins fails to disclose synchronizing step includes updating local client software for manipulating the image.

Black discloses upgrading software (col. 6, lines 26-33).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include updating or upgrading the software as disclosed by Black in the synchronizing of Wilkins, because with metadata upgrading the software can be done without system disruption and can be done during boot up.

Regarding claim 29, however it is noted that Wilkins fails to disclose alerting the user with a dialog box from which a selection can be made.

Black discloses a dialog box for alerting a user (col. 22, lines 1-3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the invention of Wilkins, a dialog box as disclosed by Black, to prove flexibility for a user.

5. Claims 24 and 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins as applied to claim 1 above, further in view of Tackbary et al., U.S. Patent Number 6,092,054.

Regarding claim 24 and 32, Wilkins discloses order parameters. (0078)

Wilkins however, fails to disclose envelope and an image metaphor including an envelope for dropping selected images into when ordering.

Tackbary discloses an envelope for selected images for ordering information.(col. 7, lines 34-61)

It would have been obvious to one of ordinary skill in the art at the time of the invention of Wilkins to include in the order information and envelope for processing selected images, as disclosed in Tackbary, to convey the urgency of the request for the processed images by the user to a processing center.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M GOOD JOHNSON whose telephone number is (571)272-7658. The examiner can normally be reached on Monday-Friday 8-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kee Tung can be reached on (571) 272-7794. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Motilewa Good-Johnson/

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Primary Examiner
Art Unit 2628

mgj